



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/652,275      | 08/31/2000  | Bruce A. Brandt      | 08049.009           | 3088             |

22852 7590 08/12/2003

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
1300 I STREET, NW  
WASHINGTON, DC 20005

EXAMINER

SCHLAK, DANIEL K

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/652,275

Applicant(s)

BRANDT ET AL.

Examiner

Daniel K Schlak

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-140 is/are pending in the application.
- 4a) Of the above claim(s) 1-36 and 71-140 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 107-140 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species II, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 13. However, the traversal has not been given any consideration because it is directed to whatever action might follow the allowance of a linking claim. Since there is no linking claim in the case, this statement is moot.

The Examiner advises applicant that the two species appear to be mere variations of the same theme, and are not necessarily patentable over each other. Therefore, if Applicant states for the record that the "software" and "hardware" recitations are obvious variations of each other, Species II will be brought back into consideration, assuming the claims of Species II still resemble those of Species I except for the hardware/software recitations.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3653

Claims 37-70 are rejected under 35 U.S.C. 102(b) as being anticipated by WO98/17405.

The Examiner is using US 6,292,709 B1 as an English translation of that document, it being believed that all of the elements used for rejection here are present in the PCT application published 4/30/1998.

See figure 13 and column 10. The reference teaches a mail processing device, an identification code reader connected to the mail processing device, and sorter application software for communicating between the mail processing device and an identification code server.

The identification code server is explicitly labeled "ID Tag server". The bar code reader (422) is the identification code reader. The sorter application software is naturally inherent in the control (421), and the ID-Tag server and sorter themselves, as a server cannot communicate with a mail sorter without some form of pertinent software, said software being considered sorting application software, because it deals with (transfers) bar code information being sent to the server, and decisions being sent to the sorter, all of which deal with sorting information.

The Examiner considers the sorters of the reference to be Mail Processing Bar Code Sorters (as they process mail and use bar code), Delivery Bar Code Sorters (as they assemble mail for delivery and use bar code), Carrier Sequence Bar Code Sorter (as they eventually deliver sorted mail to a carrier and use bar code), and Output Subsystem/Bar Code Sorters (as they are output sorters which are in themselves a subsystem and use bar code). The Examiner considers the code reader a RBCS ID

Tag reader because the reader reads an ID Tag in a bar code system which is remote of the server. The code reader is a Universal ID Tag reader because the ID Tag is also used by the network and other sorters.

As the system of Figure 13 is to be used in communication with identical systems along the network connection shown, the code server is a primary ICS server and the second, third, etc. servers in communication therewith are secondary ICS servers.

(Applicant is reminded that, unless it is wished that this application serve as lexicography code in itself, the capitalization of terms and acronyms are interpreted as broadly as possible. In any instance, the Examiner believes this reference matches up well with the devices and systems discussed in the specification.

WO98/17405, via US 6,292,709, teaches the method of reading an ID code from a mailpiece using an ID code reader, transmitting the identification code to an identification code server, via "sorter application" software, and processing mailpiece information between the sorter and the ID code server, via "sorter application" software.

The reference inherently teaches the code and computer readable medium described in relation to the system. Although it is never described verbatim in the reference, it is just as inherent in the system of the reference as it is inherent and not taught verbatim by the instant application.

The ID code is used to access results of prior processing. See "Response to Arguments" for fuller description of this feature in the references.

Claims 37-70 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,249,687.

The Examiner interprets CPU 23' as a server, insofar as it serves as the central processor and controller for at least three workstations, a communion network adaptor, a bar code reader, a shared printer, and offers communication capability with a sorter and the network itself, along the bus. Again, the "sorting application" software is inherent, in that it is impossible for the sorting machine hardware to connect to the bus without code translation or emulation of some sort.

Bar code reader is explicitly shown. The identification code of the mailpiece is described in column 5, lines 8-10. The bus and other data communication elements are described in column 6, lines 22-40.

The system of the reference creates a serial number for each mailpiece, associates it with an electronic file, and offers complete shared access along a bus, which connects to a network along 29.

A description of the general nature of this type of sorting device/method is given in column 1. Again, it is difficult for the Examiner to infer what the advantages of the claimed invention of the instant application are over this description.

Again, the computer readable medium and code of claims 69 and 139 are inherent in the fact that the reference has the components of claim 1 and performs the method of claim 47. The system of the reference would not function without such a code.

Explicitly taught are the reading of an ID code from the mailpiece, transmitting the ID code to an ID code server (controlling/serving PCU) via software, and processing mailpiece information (the electronic file and/or sorting instructions) between the sorter and the server, via the software.

The Examiner considers the sorters of the reference to be Mail Processing Bar Code Sorters (as they process mail and use bar code), Delivery Bar Code Sorters (as they assemble mail for delivery and use bar code), Carrier Sequence Bar Code Sorter (as they eventually deliver sorted mail to a carrier and use bar code), and Output Subsystem/Bar Code Sorters (as they are output sorters which are in themselves a subsystem and use bar code). The Examiner considers the code reader a RBCS ID Tag reader because the reader reads an ID Tag in a bar code system which is remote of the server. The code reader is a Universal ID Tag reader because the ID Tag is also used by the network and other sorters.

As the system of Figure 1 is to be used in communication with identical systems along the network connection shown, the code server is a primary ICS server and the second, third, etc. servers in communication therewith are secondary ICS servers.

The ID code is used to access results of prior processing. See "Response to Arguments" for fuller description of this feature in the references.

Claims 37-70 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,667,078.

As this reference is similar to US 5,249,687, the rejection is identical. The reference numbers correspond exactly. Figure 2 gives the most detailed portrayal of the elements of the independent claims of the instant application.

Claims 37-70 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,518,122.

The non-real-time CPU (275) of this reference is interpreted as the server. It communicates and controls the timing of real-time CPU, serving as the highest layer of a multi-tiered system including state supervisor, encoder supervisor, inserter supervisor, etc.

The system is modular, intended to be used with other similar systems, and providing communication links therebetween. Barcode reader (220) sends barcode information to the real-time CPU, at which time an electronic file is accessed via several alternate means. All communications are performed along a bus, and are controlled directly via a real-time CPU but run via the non-real time PC, as concerns the timing of information exchange, user prompts, etc. Sorting is performed. Although the barcode reader is not directly related to an "Identification code" as defined by applicant, the reader, mail processing device, and sorter application software exist as claimed in the independent claims of the instant application.

The code itself, its contents, its use, etc, has not been claimed in the claims of the instant application. Therefore, as the reference uses a code to identify and sort



Art Unit: 3653

documents, it still anticipates the claims through comprising all the elements of the apparatus claims and teaching the method claims.

The Examiner considers the sorters of the reference to be Mail Processing Bar Code Sorters (as they process mail and use bar code), Delivery Bar Code Sorters (as they assemble mail for delivery and use bar code), Carrier Sequence Bar Code Sorter (as they eventually deliver sorted mail to a carrier and use bar code), and Output Subsystem/Bar Code Sorters (as they are output sorters which are in themselves a subsystem and use bar code). The Examiner considers the code reader a RBCS ID Tag reader because the reader reads an ID Tag in a bar code system which is remote of the server. The code reader is a Universal ID Tag reader because the ID Tag is also used by the network and other sorters.

The ID code is used to access results of prior processing. See "Response to Arguments" for fuller description of this feature in the references.

The Examiner notes, for the record, his interpretation of the term "server".

A "server" is defined by Webster (10<sup>th</sup> Edition) as being "a computer in a network that is used to provide services (as access to files or shared peripherals or the routing of electronic mail) to other computers in the network.

Thus, the presence of a bus in each reference, with at least a plurality of components, each comprising a processor itself, controlled by a master PC, evidences of a server, even though the word "server" is not used.

Art Unit: 3653

Further, it is clear from the above definition and from the Examiner's own use of email that an Email server in an agency, company, or firm, also anticipates the independent claims of the instant application. As email is sorted on each user's PC and each email is associated with an identifier on the network and in the server.

### ***Response to Arguments***

Applicant's arguments filed 5/28/03 have been fully considered but they are not persuasive.

Applicant has amended the independent claims to recite that the identification code is used to access "results of prior processing". None of the rejections posed in the first Office action on the merits have been traversed. The only argument presented for the patentability of the amended claims is a re-assertion of the "results of prior processing" recitation and the allegation that this is not to be found in the references.

However, Applicant seems to have the perception that the term "prior processing" is limited to one specific phenomenon. The Examiner, in interpreting the claims as broadly as literally possible, as is Office policy, clearly interprets "prior processing" more broadly than is the intent of Applicant. To begin with, what is the basis for "prior"? Prior to what? Without basis, there is no reason for the Examiner to infer that "prior" means anything other than "before terminal sortation of the mailpiece", or even more broadly, "prior to the next lunar eclipse in Guam" or "prior to the next ice age", etc. Recitations such as "prior" require very explicit and unambiguous basis for interpretation.

Further, the term "processing" can be interpreted in an infinitely broad sense. The "results of prior processing of the mailpiece" in this case has been interpreted as "any activity performed whatsoever which resulted from an indicium on the mailpiece". For instance, the most pertinent example of this interpretation is US 5,667,078 to Walach. Walach, in columns 3 and 4, actually uses the word "processed" in the description of what is done with the mailpiece information. The sorter application software for communicating between the mail processing device and the ID code server does in fact use the ID code for re-associating the mail-piece with its file. The file is specifically comprised of information that was "processed off line" (column 3, lines 56-58), and is used to "process" the mailpiece to a desired level. In the latter instance, "process" is interpreted as "sorted".

In other words, the undergoing of any process is considered "processing". Of course the processing is "prior" because the off-line "processing" was done "prior" to the arrival of the mailpiece to the receiving location.

Similarly, column 1, lines 15-20, of 5,249,687 to Rosenbaum et al., teaches what is called "just-in-time manufacturing" applied to mail sorting, in what is described as "process of deferred processing" (here, particularly, the broadness of the word "process" becomes almost ironic). Images within an electronic folder pertaining to each ID code are "processed" while the mail is in transit from a sending location to a "destination postal location". In other words, the mailpiece is, in a broad interpretation, "processed,"

Art Unit: 3653

and it is done so "prior" to arrival at the destination location. The "result" of the processing is the resolved information in the electronic file itself.

Similar rationale goes to show that Tilles '122 and Uhl et al. '709 (on behalf of WO98/17405) teach "results of prior processing" being used, at least in part, for at least some of the determination undergone in getting each mailpiece "processed" to a desired level. On this note, the question is posed; If a system/method uses an OCR, software/hardware, communications, an ID code, and a server to ensure the mailpiece is processed to a desired level, how on Earth could it be done *without* results of some 'prior' process?

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3653


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4195 for regular communications and 703-306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308 - 1113.

dk  
August 7, 2003

  
DONALD P. WALSH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600